

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

### **REMARKS**

Applicant has cancelled Claims 16-19 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

Applicant has amended Claims 1, 9 and 20 to add the limitation that the razor blade has a straight cutting edge, and that the cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle. Support for this amendment can be found, for example, in Figures 1 and 7. Claim 1 is also amended so that the control angle is less than or equal to ninety degrees. Support for this amendment can be found, for example, in paragraph [0029]. Applicants have amended Claims 1 and 5 to reference the width of the head portion rather than the razor blade. Support for this amendment can be found, for example, paragraph [0031]. Claim 4 is amended to be in independent form. Claims 14 and 15 have been amended to correct an inadvertent error so that they now depend from Claims 13 and 10 rather than Claim 1. New claims 21-28 are added. Support for these claims can be found, for example, in the claims as originally filed.

Claims 1-15 and 20-28 are presented for examination. Applicant responds below to the specific rejections raised by the PTO in the Office Action mailed February 28, 2005. For the reasons set forth below, Applicant respectfully traverses.

#### **Rejection under 35 U.S.C. § 112, second paragraph – Indefiniteness**

The PTO has rejected Claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite. The PTO argues that the recited control angle cannot be both less than and greater than ninety degrees. Applicant has amended Claim 4 to be in independent form, such that the control angle is greater than ninety degrees. In view of this amendment, Applicant requests that the rejection of Claim 4 under 35 U.S.C. § 112, second paragraph, be withdrawn.

#### **Provisional Rejection under Doctrine of Obviousness-type Double Patenting**

The PTO has provisionally rejected the Claims 9, 14, 16, 17, and 20 as not being patentably distinct from Claims 1, 7, 10, 13-21 of co-pending Application No. 10/219,095, the parent application from which the instant application claims priority. As no claims of co-pending

Appl. No. : 10/648,686  
Filed : August 25, 2003

Application No. 10/219,095 have been allowed, Applicants choose not to respond to the provisional rejection at this time.

**Rejection under 35 U.S.C. §102(b) – Anticipation**

The PTO has rejected Claim 16 as anticipated under 35 U.S.C. §102(b) by Hollinger, U.S. Design Patent 259,743 (Hollinger). According to the PTO, Hollinger discloses the same invention as claimed including the step of, e.g., forming razor head with an integral razor blade as shown in Figure 5; forming a handle for mounting the head as shown in Figure 1; forming an upper longitudinal portion (3) having a first end attached to the handle and a second end displaced from the handle as shown in Figure 1; and attaching the razor head to the second end of the upper longitudinal portion as shown in Figure 1.

Applicant has canceled Claim 16, rendering this rejection moot.

**Rejection under 35 U.S.C. §103(a) – Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 2143 (8<sup>th</sup> ed. 2004). Applicants respectfully submit none of these criteria have been met and that therefore the PTO has failed to establish a *prima facie* case of obviousness for Claims 1-15 and 17-20 as presented herein.

**Claims 1-8, 21-22 and 27-28**

The PTO rejects Claims 1-2 and 4-8 under 35 U.S.C. § 103(a) as being unpatentable over in light of the combination of Hollinger (U.S. Design Patent 259,743) and Carreker (U.S. Patent No. 4,461,078). The PTO argues that:

Hollinger discloses the same invention as claimed including, e.g., a handle portion (H1) having a lower (1), middle (2), upper (3) longitudinal portions; and a head portion (H2) having a razor blade (see claim) attached to said upper longitudinal portion (see Figure 1); wherein the lower longitudinal portion extends along a first axis (A1), the middle longitudinal portion extends along a second axis (A2); and the upper longitudinal portion extends along a third axis (A3). The first and third

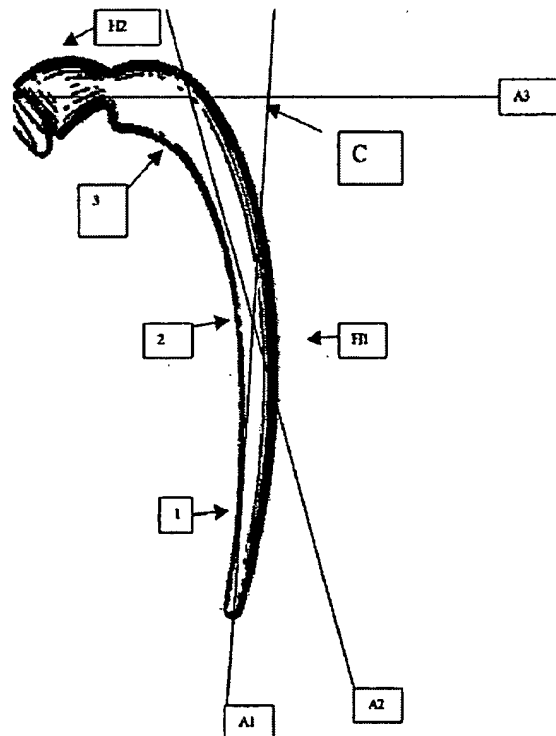
Appl. No. : 10/648,686  
Filed : August 25, 2003

axes form a control angle (C) that is less than ninety degrees (see the Figure below). Office Action at 4.

The PTO acknowledges that Hollinger “lacks the razor blade having a width of less than or equal to one inch.” *Id.* However, the PTO argues that “Carreker discloses that is it old and well known in the art to use razor blades of reduced size such less than one inch for the purpose of provided an improved razor with an enhanced cutting ability of specific small areas of the body.” *Id.* The PTO concludes that therefore, “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced razor blade size of less than one inch with the safety razor of Hollinger in order to provide an enhanced cutting razor for specific grooming.” *Id.* The PTO also rejects Claim 3 under 35 U.S.C. 103(a) as being unpatentable over Hollinger in view of Carreker as applied to claim 1 above, and further in view of Branchinelli et al., U.S. patent 6,052,905.

Applicant respectfully disagrees.

The “Figure below” from the Office Action referred to in the above paragraph is reproduced below.



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**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

Applicant turns first to the third element of a prima facie case of obviousness - that the prior art reference(s) must teach or suggest all the claim limitations. Amended Claims 1 and 4, and therefore dependent Claim 2-3, 5-8, 21-22, and 27-28 require that the claimed razor have “a handle portion having lower, middle and upper longitudinal portions; ...wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis.” The handle disclosed by Hollinger is a continuous curve. As a result, contrary to the PTO’s assertion, Hollinger does not disclose a handle having lower, middle and upper longitudinal portions that extend along a first, second, and third axis. While the continuous curve disclosed by Hollinger could arbitrarily be divided into sections, the continuous nature of the curve means that the lower, middle, and upper portions of the curve do not extend along a first, second, and third axis as required by Claims 1-8. This is made apparent by the fact that the placement of the lines A1, A2, and A3 in the above figure is arbitrary. For example, because the “lower portion” could be defined as any part of the lower portion of the curved handle, the line A1 could be placed anywhere along the continuous curve of the handle. As a result, the “control angle (C)” identified by the PTO could have a value of less than 90 degrees, equal to 90 degrees, or greater than 90 degrees, depending on where line A1 is placed. In contrast, the handle shown in Figure 6 of the instant application has identifiable lower, middle and upper longitudinal portions that extend along a first, second, and third axis.

Thus, Applicants submit that Hollinger, even when combined with Carreker and Branchinelli, lacks the limitation “a handle portion having lower, middle and upper longitudinal portions; ...wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis.” For at least this reason, Applicant respectfully submits that Claims 1-8 are not obvious in light of the cited art, and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

Applicant next turns to the PTO’s argument that “Carreker discloses that is it old and well known in the art to use razor blades of reduced size such less than one inch for the purpose of provided an improved razor with an enhanced cutting ability of specific small areas of the body” and that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced razor blade size of less than one inch with the safety razor

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

of Hollinger in order to provide an enhanced cutting razor for specific grooming.” Office Action at 4.

Applicant turns next to the first element of a prima facie case of obviousness - that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. “The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’” M.P.E.P. §2142, *quoting Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (BPAI 1985).

Applicant submits that the PTO has not established any motivation to combine the decorative handle of Hollinger with the small blade disclosed by Carreker. The M.P.E.P. states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis added). In addition, the M.P.E.P. requires that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. §2141.02 (emphasis in original).

The Carreker reference discloses a handle with two straight portions, and a razor head mounted at the ends of the handle portions. (Figs. 1-3). The handle portions are “pivotally mounted together so that the heads may be moved from a position wherein the handle portions are substantially in a straight line” to a closed position where the heads are close to each other. Carreker at Abstract. In the Detailed Description of the Drawings, Carreker teaches that that when the handles are in straight line position shown in FIG. 1, “the razors ... are disposed for use in shaving.” Carreker at col. 2, lines 59-68 (emphasis added). The fact that the assembly is used for shaving with the handles in the straight line position shown in FIGS. 1 and 5 is repeated elsewhere as well. Carreker at col. 3, lines 58-59. In addition, Carreker teaches that the two handle portions are provided with “stops ... formed integrally therewith for defining the first [straight line] position (FIG. 1) of the handle portions.” Carreker col. 3, lines 22-27.

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

When the two-piece handle of Carreker is in a straight line, it is essentially a single, long straight handle. Carreker could have placed the stops such that the two handles formed any angle around the pivot point. In doing so, Carreker could have created a handle that more closely resembled the one disclosed in Hollinger, or the instant application. However, rather than choosing some angle less than or greater than 180 degrees, Carreker chose to create essentially a straight handle for shaving. Thus, when the whole of the Carreker reference is considered, it clearly teaches away from combining the disclosed smaller razor head with anything other than a straight handle. Hollinger, as a design patent, teaches absolutely nothing with regard to reasons to combine it with the Carreker reference.

In conclusion, the PTO has not offered any reason or motivation to combine the Hollinger and Carreker references, and references themselves teach away from the combination. Therefore, Applicant submits that the PTO has failed to establish the first element of a prima facie case of obviousness. For this additional reason, Applicant respectfully submits that Claims 1-8 are not obvious in light of the cited art, and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

*Claims 9-15 and 23-24*

The PTO has rejected Claims 9-10 and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Hollinger in view of Andrews, U.S. Patent 6,145,201, or Heinrich, U.S. Patent 2,139,680. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollinger in view of Andrews or Heinrich as applied to claim 9, and further in view of Carreker. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollinger in view of Andrews or Heinrich as applied to claim 9, and further in view of Branchinelli et al., U.S. patent 6,052,905.

The PTO argues that Hollinger discloses the same invention as claimed including, e.g., an ergonomically shaped handle having a razor blade attached to the upper longitudinal portion. The PTO argues that while “Hollinger lacks the razor blade having a width of less than 1/2 inch,” “Andrews (.4 inches) and Heinrich (.375 inches) both discloses that is it old and well known in the art to use razor blades of reduced size such less than 1/2 inch for the purpose of provided an improved razor with an enhanced cutting ability of specific small areas of the body.” Office Action at 8. The PTO also states that “[i]t should be noted that the phrase ‘wherein said handle portion is adapted to ... shaving’ does not serve to distinguish the claimed invention from the

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

prior art as it is merely intended use not defining any specific structure.” Office Action at 7. The PTO concludes that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced razor blade size of less than one inch with the safety razor of Hollinger in order to provide an enhanced cutting razor for specific grooming.” Office Action at 8.

As stated above, the first element of a prima facie case of obviousness is a that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. “The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’” M.P.E.P. §2142, *quoting Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (BPAI 1985).

Applicant submits that the PTO has not established any motivation to combine the decorative handle of Hollinger with the small blade disclosed by Andrews or Heinrich. The M.P.E.P. states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis added). In addition, the M.P.E.P. requires that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. §2141.02 (emphasis in original). Similarly, “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01. Finally, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.” *Id.*

Andrews discloses “small, lightweight manual mustache shaving devices having a razor-sharp cutting edge and a fingertip grip which can easily be gripped between and controlled by a user's fingertips for precise mustache cutting and shaving.” Andrews at col. 1, lines 16-20. Throughout Andrews, in the figures as well as the text, the disclosed shaving device has a grip

Appl. No. : 10/648,686  
Filed : August 25, 2003

adapted for holding between the thumb and forefinger. *See, e.g.*, Figs. 13 and 15; col. 3, lines 57-59 (“The fingertip grip portion has an overall size approximately as large the area between tips of the user's thumb and forefinger when the tips are pressed together.”). Andrews teaches that a grip portion any larger than the “fingertip grip” disclosed in the patent is undesirable. Andrews states that:

FIG. 15 is another view of device 80 held by a pinch grip between the tips of a user's thumb and forefinger. FIG. 15 also illustrates the importance of having the pinch grip tab be sufficiently small, rather than too large, as will now be explained. A tab portion that is too large is represented by tab portion 82'. The extra area of tab portion 82' that extends beyond tab 82 is lined with dashes for ease of identification. Tab 82', in my view is too large, because it protrudes beyond the tips of the gripping finger and thumb, and thus its rear area 84 may accidentally rub against the user's central finger. This kind of interference is undesirable, since it hinders making precise fingertip movements of the blade. Avoiding this potential problem is one of the reasons I strongly prefer that my mustache shaving devices to be two inches or less in overall length, and to have a fairly small gripping area just large enough to accommodate a fingertip pinch grip of an average size man's hand. Andrews at col. 14, lines 22-39 (emphasis added).

These statements clearly teach away from combining the small razor blade disclosed in Andrews with the decorative handle of Hollinger. In addition, given these statements, one of skill in the art would view the resulting modified Andrews device as “unsatisfactory for its intended purpose” since the large handle of the modified device “hinders making precise fingertip movements of the blade.” Finally, the proposed combination of the cited art would “change the principle of operation” of the Andrews invention since it would no longer be easily gripped between the thumb and forefinger, and it would no longer be manipulated by the users fingertips alone. *See* Andrews col. 3, lines 44-49 (stating that the devices of the invention are “especially arranged so that they can be easily gripped by the user between his fingertips and manipulated by finger movement alone”). Thus, considering the Andrews reference as a whole, Applicant submits that the PTO has not offered any reason or motivation to combine the Hollinger and Andrews references, and references themselves strongly teach away from the combination. Therefore, Applicant submits that the PTO has failed to establish the first element of a prima facie case of obviousness with respect to the Hollinger and Andrews references.

In addition, if the handle of Hollinger were combined with the blade of Andrews, the resulting device would not satisfy the requirement that the prior art reference(s) teach or suggest all the claim limitations. The Andrews blade is oriented parallel to the long axis of the fingertip



**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

grip. If the grip were replaced with the handle of Hollinger, the modified device would not satisfy the limitation “wherein a cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle” of independent Claim 9 and dependent Claims 10-15. Applicant submits that the PTO has therefore also failed to establish the third element of a prima facie case of obviousness with respect to the Hollinger and Andrews references.

Applicant turns next to the PTO’s suggested combination of the Hollinger and Heinrich references. The PTO’s reason for asserting that it would have been obvious to combine Hollinger and Heinrich is that Heinrich discloses “that is it old and well known in the art to use razor blades of reduced size such less than 1/2 inch for the purpose of provided an improved razor with an enhanced cutting ability of specific small areas of the body.” Office Action at 8. Based on this assertion, the PTO concludes that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced razor blade size of less than one inch with the safety razor of Hollinger in order to provide an enhanced cutting razor for specific grooming.

First, Applicants submit that the PTO has not provided any motivation to combine the razor disclosed in Heinrich with the handle disclosed in Hollinger. As mentioned above, the M.P.E.P. states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis added). Similarly, “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01.

The device of Claims 9-15 is a “detail shaving razor.” The dictionary definition of “shave” is “to sever the hair (from the head or another part of the body) close to the roots.” Webster’s Ninth New Collegiate Dictionary, 1983. Applicant hereby expressly adopts this definition of shaving. The razor disclosed by Heinrich is designed for the purpose of cutting hair in the nostrils and ears (col. 1, lines 5-23), but does not shave a body part. Referring to Figures 1-3 of Heinrich, the blade 17 overlays a plate 10 with teeth 11 that extend well beyond the blade. This prevents cuts when poking the cutting head into the nose or the ears, but it also prevents the blade from severing the hair “close to the roots” as is required when shaving. This reference is outside of the family of razors that shave a body surface. For example, if one were to use the

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

razor described by Heinrich in the bikini area, the stubble created by such an incomplete hair removal would lead to intense irritation.

In addition, the blade disclosed in Heinrich is curved, further diminishing its usefulness as a “detail shaving” razor. The present invention is directed to precise shaving to shape body hair such as the eyebrows or a mustache, often involving cutting single hairs. The curved blade of Heinrich makes cutting fine details difficult compared to blades which are straight. These difference exclude Heinrich from the devices to which one trying to shave a difficult area, (e.g., the eyebrows, scalp, sideburns and bikini area) would look for guidance. Heinrich does not teach a razor capable of achieving such a goal. Therefore, there is no motivation to combine the Heinrich and Hollinger references to create a “detail shaving” razor.

Also contrary to any motivation to combine the Hollinger and Heinrich references is the fact that the resulting device would not be operable for the purpose of either of the cited references. If the standard blade of Hollinger were replaced with the smaller curved blade of Heinrich, the resulting device would be inoperable for the purpose of trimming the hair inside the nose and ears as taught in the Heinrich reference. The standard size razor head of Hollinger, even with a small razor blade, would not fit into the nostril of the ear. Similarly, shaving large areas of the body such as the face or legs would be impractical with the standard razor handle of Hollinger combined with the small blade of Heinrich. Thus, the combined device would be inoperable for the purposes disclosed in either Hollinger or Heinrich. “If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01.

The PTO has also failed to satisfy the second element of a prima facie case of obviousness – a reasonable likelihood of success. The precise detail shaving of areas such as eyebrows, scalp, sideburns or bikini area requires that the user know where the edge of the razor blade is, since it often requires cutting as few as one or two hairs. Placing a curved small blade on the standard size head of the Hollinger razor would not enable the precise shaving required since both the large head size of Hollinger and the curve of the Heinrich blade would obscure the precise location of the edge of the razor blade. The blade would be hidden, and a user would have to simply guess where the blade was when trying to shave with it – an imprecise situation at best, and potentially dangerous when shaving constrained or sensitive areas. Therefore, the PTO

Appl. No. : 10/648,686  
Filed : August 25, 2003

has not established the second element of a prima facie case of obviousness since there is no reasonable likelihood of success of obtaining the claimed invention by combining the Hollinger and Heinrich references.

Finally, the PTO has failed to establish the third element of a prima facie case of obviousness – that the prior art reference(s) must teach or suggest all the claim limitations. As amended, the detail shaving razor of independent Claim 9, and therefore dependent Claims 10-15 and 23-24 has “a head portion attached to said handle portion and formed with at least one razor blade having a straight cutting edge; wherein said head portion is less than or equal to 1/2 inch wide.”

As discussed above, a straight cutting edge is important for being able to accurately shave fine details. The combined device does not meet the claim limitation “at least one razor blade having a straight cutting edge” since the blade of Heinrich is curved. In addition, placing the small curved blade of Heinrich in the standard handle of Hollinger does not result in a handle “wherein said head portion is less than or equal to 1/2 inch wide.” While the Heinrich blade may be smaller than 1/2 inch wide, the “head portion” of the Hollinger handle identified by the PTO is the width of a standard razor, which is not less than or equal to 1/2 inch wide. For at least these reasons, Applicant submits that the PTO has failed to establish that the cited references teach or suggest all the claim limitations of Claims 9-15 and 23-24.

Claim 10, and therefore dependent Claims 11-15, recites:

10. The detail shaving razor of Claim 9, wherein said handle portion further comprises:  
a lower longitudinal portion of a **first curved shape**; and  
a middle longitudinal portion of a **second curved shape** attached lengthwise to said first longitudinal portion;  
wherein a waist portion is formed between said first curved shape and said second curved shape. (emphasis added).

As discussed above, the main portion of the handle disclosed in Heinrich is a single continuous curve. The PTO attempts to overcome this fact by arguing that:

Hollinger discloses the use of a lower longitudinal portion extends along a first curved shape (A1), the middle longitudinal portion extends along a second curved shape (A2); and the upper longitudinal portion extends along a third curved shape (A3). The first and second portions define a waist portion therebetween (the section between the first and second portions). Office Action at 8.

Appl. No. : 10/648,686  
Filed : August 25, 2003

Applicant submits that portions (A1) and (A2) of Hollinger are not a **first curved shape** and a **second curved shape**, but rather are a single curved shape. There is no support in Hollinger for the PTO's division of this single curve into two portions, and doing so does not create a first and second curved shape. This is in contrast to the distinct first and second curved portions of the handle shown in embodiment illustrated in Figure 1 of the instant application. For at least this additional reason, Applicant submits that the PTO has failed to establish that the cited references teach or suggest all the claim limitations of Claims 10-15 and 23-24.

In conclusion, Applicants submit that for at least the reasons stated above, the PTO has failed to establish a prima facie case of obviousness in light of the cited art for Claims 9-15 and 23 -24, and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

#### Claims 17-19

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Design Patent 259,743 to Hollinger. The PTO argues that Hollinger discloses the invention substantially as claimed. As to claim 18, the PTO argues that the modified device of Hollinger discloses the invention substantially as claimed except for the control angle being greater than ninety degrees, but that it would have been obvious to one having ordinary skill in the art to use a control angle of greater than ninety degrees. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollinger as applied to claim 18 above, and further in view of Carreker.

Applicant has canceled Claims 16-19, rendering this rejection moot.

#### Claims 20 and 25-26

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollinger in view of Heinrich and White, U.S. Patent 4,719,063, or Holley, U.S. Patent 6,049,936, or Brody, U.S. Patent 4,523,781, or Beebe, U.S. Patent 4,283,808, and/or Gaide, U.S. Patent 2,367,571, or Lovasz, U.S. Patent 2,743,732, or Bosy et al., U.S. patent 6,598,303. The PTO argues that Hollinger discloses the invention substantially as claimed including a generally arcuate handle with means (the curved upper end) for improved manipulation. The PTO acknowledges that Hollinger lacks the shaving head being less than or equal to three-eighths of an inch wide. However, the PTO states that in light of Heinrich, would have been obvious to one of ordinary skill in the art to use a reduced razor blade size of less than or equal to 3/8 of an inch with the

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

safety razor of Hollinger. The PTO also acknowledges that Hollinger lacks the limitation that the width of at least a portion of the handle being substantially larger than the width of the shaving head. The PTO argues that this would have been obvious in light of White, Holley, Brody, Beebe, Gaide, Lovasz, or Bosy.

As discussed at length above with respect to Claims 9-15 and 23-24, Applicant submits that the PTO has failed to establish any of the three elements of a prima facie case of obviousness with respect to the combination of the Hollinger and Heinrich references. This same reasoning applies to Claims 20 and 25-26.

The PTO's reason for asserting that it would have been obvious to combine Hollinger and Heinrich is that Heinrich discloses "that is it old and well known in the art to use razor blades of reduced size such as less than or equal to 3/8 of an inch for the purpose of provided an improved razor with an enhanced cutting ability of specific small areas of the body." Office Action at 12. Based on this assertion, the PTO concludes that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced razor blade size of less than one or equal to 3/8 of an inch with the safety razor of Hollinger in order to provide an enhanced cutting razor for specific grooming. No support is cited for the desirability of making such modifications or for achieving this vaguely-stated goal.

First, Applicants submit that the PTO has not provided any motivation to combine the razor disclosed in Heinrich with the handle disclosed in Hollinger. As mentioned above, the M.P.E.P. states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. §2143.01 (emphasis added). Similarly, "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. §2143.01.

The device of Claims 20 and 25-26 is a personal styling razor, comprising "a shaving head." The dictionary definition of "shave", hereby expressly adopted by the Applicant, is "to sever the hair (from the head or another part of the body) close to the roots." Webster's Ninth New Collegiate Dictionary, 1983. The razor disclosed by Heinrich is designed for the purpose of cutting hair in the nostrils and ears (col. 1, lines 5-23), but does not shave a body part. Referring to Figures 1-3 of Heinrich, the blade 17 overlays a plate 10 with teeth 11 that extend well beyond

Appl. No. : 10/648,686  
Filed : August 25, 2003

the blade. This prevents cuts when poking the cutting head into the nose or the ears, but it also prevents the blade from severing the hair “close to the roots” as is required when shaving. This reference is outside of the family of razors that shave a body surface. For example, if one were to use the razor described by Heinrich in the bikini area, the stubble created by such an incomplete hair removal would lead to intense irritation.

In addition, the blade disclosed in Heinrich is curved, further diminishing its usefulness as a “detail shaving” razor. The present invention is directed to precise shaving to shape body hair such as the eyebrows or a mustache, often involving cutting single hairs. The curved blade of Heinrich makes cutting fine details difficult compared to blades which are straight. These difference exclude Heinrich from the devices to which one trying to shave a difficult area, (e.g., the eyebrows, scalp, sideburns and bikini area) would look for guidance. Heinrich does not teach a razor capable of achieving such a goal. Therefore, there is no motivation to combine the Heinrich and Hollinger references to create a personal styling razor for shaving.

Also contrary to any motivation to combine the Hollinger and Heinrich references is the fact that the resulting device would not be operable for the purpose of either of the cited references. If the standard blade of Hollinger were replaced with the smaller curved blade of Heinrich, the resulting device would be inoperable for the purpose of trimming the hair inside the nose and ears as taught in the Heinrich reference. The standard size razor head of Hollinger, even with a small razor blade, would not fit into the nostril of the ear. Similarly, shaving large areas of the body such as the face or legs would be impractical with the standard razor handle of Hollinger combined with the small blade of Heinrich. Thus, the combined device would be inoperable for the purposes disclosed in either Hollinger or Heinrich. “If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01.

The PTO has also failed to satisfy the second element of a prima facie case of obviousness – a reasonable likelihood of success. The precise detail shaving of areas such as eyebrows, scalp, sideburns or bikini area requires that the user know where the edge of the razor blade is, since it often requires cutting as few as one or two hairs. Placing a curved small blade on the standard size head of the Hollinger razor would not enable the precise shaving required since both the large head size of Hollinger and the curve of the Heinrich blade would obscure the

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

precise location of the edge of the razor blade. The blade would be hidden, and a user would have to simply guess where the blade was when trying to shave with it – an imprecise situation at best, and potentially dangerous when shaving constrained or sensitive areas. Therefore, the PTO has not established the second element of a prima facie case of obviousness since there is no reasonable likelihood of success of obtaining the claimed invention by combining the Hollinger and Heinrich references.

Finally, the PTO has failed to establish the third element of a prima facie case of obviousness – that the prior art reference(s) must teach or suggest all the claim limitations. As amended, the personal styling razor of independent Claim 20, and therefore dependent Claims 25-26 has “a shaving head having at least one razor blade, wherein said shaving head is less than or equal to three-eighths of an inch wide, wherein said razor blade has a straight cutting edge.”

As discussed above, a straight cutting edge is important for being able to accurately shave fine details. The combined device does not meet the claim limitation “at least one razor blade having a straight cutting edge” since the blade of Heinrich is curved. In addition, placing the small curved blade of Heinrich in the standard handle of Hollinger does not result in a handle “wherein said shaving head is less than or equal to three-eighths of an inch wide” Even if the Heinrich blade is less than or equal to three-eighths of an inch wide, the “shaving head” of the Hollinger handle identified by the PTO is the width of a standard razor, which is not less than or equal to three-eighths of an inch wide. For at least these reasons, Applicant submits that the PTO has failed to establish that the cited references teach or suggest all the claim limitations of Claims 20 and 25-26.

Applicant submits that the PTO has failed to establish any of the three elements of a prima facie case of obviousness for Claims 20 and 25-26, and therefore Applicant respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

#### New Claims 21-28

New Claims 21-28 recite limitations wherein the head portion of the razor is less than or equal to 1/4 or 1/8 inch wide. Applicant respectfully submits that such extremely small sizes are not taught by the cited art, and the motivation for reducing the size of the blade to such small dimension, which enables styling and shaving the hair of the scalp, eyebrows, etc., including shaving detailed designs or single hairs at a time, is not found in the cited art. Therefore, as none

**Appl. No.** : **10/648,686**  
**Filed** : **August 25, 2003**

of the cited art teach such small sizes, and there is no motivation to modify the cited art, the PTO has failed to establish a prima facie case of obviousness with respect to new Claims 21-28.

### **CONCLUSION**


In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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